Supreme Court of the United States.

OCTOBER TERM, A. D. 1901.

KOKOMO FENCE MACHINE COMPANY, *Petitioner,*
vs.
ALVA L. KITSELMAN AND DAVIS M. KITSELMAN, *Respondents.*

Petition for Writ of Certiorari directed to U. S. Circuit Court of Appeals for the Seventh Circuit.

PETITION FOR WRIT OF CERTIORARI, AND BRIEF IN SUPPORT THEREOF.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The petition of the Kokomo Fence Machine Company, the defendant in the above-entitled cause, represents and shows unto your Honors as follows:

History of Proceedings.—On the 15th day of March, 1898, the respondents filed their bill of complaint in the Circuit Court of the United States for the District of Indiana against your petitioner and others, charging infringement by them of letters patent of the United States No. 289,507, issued December 4, 1883, to William J. Davisson, for Machine for Making Wire Fabrics; No. 356,322, issued January 18, 1887, to Alva L. Kitselman and

Davis M. Kitselman, for Wire Fabric Machine; No. 357,-067, issued February 1, 1887, to Theodore M. Connor, for Machine for Forming Netted Wire Fabrics, and No. 505,-607, issued September 26, 1893, to John C. Pope, for Wire Fabric Machines, and praying an injunction and accounting of profits and damages in accordance with the usual practice in such cases. (1-12.)

On the 28th day of April, 1898, your petitioner filed its answer to said bill of complaint (13-23) and on the second day of June, 1898, the complainants filed their replication to said answer. (24-25.)

The issues being joined as above, proofs were taken at length on both sides (27-518) and the case brought on to final hearing before his Honor Judge John H. Baker, District Judge, and on the 9th day of October, 1899, Judge Baker announced a decision in your petitioner's favor, holding that the claims of the four letters patent sued on were for specific constructions which your petitioner did not use, and that there was, therefore, no infringement of said letters patent, or either of them. (792-797.)

After the decision by Judge Baker in favor of your petitioner and holding that it did not infringe either of said letters patent the complainants appealed the case to the United States Circuit Court of Appeals for the Seventh Circuit, assigning errors and filing bond and perfecting said appeal. (797-801.)

After the case was docketed in the United States Circuit Court of Appeals for the Seventh Circuit it came on for hearing before their Honors Judges William A. Woods

and Peter S. Grosscup, Circuit Judges, and Judge William H. Seaman, District Judge, and was argued before them on the 8th day of June, 1900, and taken by them under advisement.

On the 9th day of April, 1901, the United States Circuit Court of Appeals for the Seventh Circuit announced the decision of the court through Judges Grosscup and Seaman—Judge Woods dissenting—reversing Judge Baker as to the Kitselman patent, holding that the defendants had infringed the first, second, eleventh and fifteenth claims thereof, and apparently announcing no decision whatever as to the Davisson, Connor and Pope patents.

On the first day of May, 1901, your petitioner filed a petition for rehearing in the United States Circuit Court of Appeals for the Seventh Circuit, which petition was, on the 15th day of May, 1901, overruled without any opinion being filed or pronounced by the court. Thereupon a mandate was issued to the Circuit Court and Judge Baker entered a decree against your petitioner and dismissed the bill of complaint as to the individual defendants, leaving your petitioner the sole defendant in said cause.

Differences of Opinion.—As a part of this petition your petitioner submits herewith a certified copy of the record in said cause, showing all proceedings therein, both in said Circuit Court and Circuit Court of Appeals. As shown by this record, the contention at the hearings in both said courts, so far as concerns present questions, was in reference to the validity and infringement of the said first, second, eleventh and fifteenth claims of the said Kitselman patent, among others, and as to these questions

Circuit Judge Grosscup and District Judge Seaman took one view, and Circuit Judge Woods and District Judge Baker a different and contrary view—the one Circuit and District Judge holding that there was infringement and the other Circuit and District Judge holding that there was not—as will appear by the record herein.

Specific Assignment of Errors.

Your petitioner respectfully shows and insists that the majority decision of the United States Circuit Court of Appeals is erroneous in the following particulars:

I. In finding infringement, notwithstanding the alleged infringing acts were committed at a *particular place* and the patentees admit that *subsequent* to the issuance of the patent and *prior* to the alleged infringing acts they had sold *portions* of the United States, but failed to show that the alleged infringing acts were committed in territory *still* retained and owned by them.

II. In holding the Kitselman patent to be a pioneer patent for a portable or field machine, notwithstanding it was old to make *one* style of fencing with a portable field machine, and the Kitselman patent simply made *another* style of fencing which was itself old.

III. In holding that the Kitselman patent was infringed, even if it be considered as a pioneer patent, in view of the wide difference in mechanism and mode of operation employed in the defendant's machine.

IV. In holding that the Kitselman patent introduced various novelties in construction and operation which were really old in other patents long prior thereto and not referable to Kitselman.

Wherefore, your petitioner prays that this Honorable Court will take cognizance of the matters herein set forth and referred to and will grant unto your petitioner a writ of certiorari requiring said cause and the record thereof to be certified to it by the United States Circuit Court of Appeals for the Seventh Circuit, for its review and determination, pursuant to the provisions of the statute in such case made and provided, and that your petitioner may have such other and further relief in the premises as the nature and circumstances of its case may require.

And your petitioner will ever pray, etc.

KOKOMO FENCE MACHINE COMPANY,
BY J. E. FREDERICK,
Secy. and Treas.

STATE OF INDIANA,
HOWARD COUNTY. } ss.

JOHN E. FREDERICK, secretary and treasurer of the Kokomo Fence Machine Company, the above-named petitioner, being duly sworn, upon oath says that he has read the foregoing petition subscribed by him and knows the contents thereof, and that the same is true in substance and matter of fact as he verily believes.

JOHN E. FREDERICK.

Subscribed and sworn to before me this 3rd day of June, 1901.

JAMES C. BLACKLIDGE,
[SEAL.] Notary Public.

We hereby certify that the foregoing stated grounds in support of the petition for writ of certiorari in the above-entitled cause are, in our opinion, well founded in point of law.

THOMAS A. BANNING,
EPHRAIM BANNING,
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION.

1. *The First Question Presented.*—Does a patentee show infringement where the alleged infringing acts were committed at a *particular* place and he admits that *subsequent* to the issuance of the patent and *prior* to the alleged infringing acts he has sold *portions* of the United States *without* showing that the alleged infringing acts were committed in territory *still* owned by him?

The Kitselman patent was issued directly to the complainants and on its face vested them with full title throughout the whole of the United States. It appears, however, from the deposition of Mr. Kitselman that since the issuance of the patent and prior to the commencement of the suit the complainants sold various state and county rights, so that they did not at the time of the commencement of the suit own such states and counties. Mr. Kitselman, on page 131 of the Record, testified to the sale of territorial rights under the Kitselman patent in which they sold the exclusive right to *make, sell and use,* and in which he says the particular territory sold was specified in the deed. On page 131 of the Record Kitselman was asked:

> "X-Q. 56. When you sold the territorial rights, as you say, the particular territory was specified in the deed and the right was *exclusive* in the purchaser, was it not?
>
> "A. It was a mere license and *exclusive* so far as the sale and use were concerned.
>
> "X-Q. 57. And this was also true, was it not, of those which also included the right to *manufacture*?
>
> "A. Yes, sir."

On page 137 Mr. Kitselman was again asked in reference to the matter, and testified as follows:

> "X-Q. 90. Were the territorial rights which you sold under the Kitselman patent sued on in this case for townships, counties or states?
>
> "A. Mostly for counties. We sold some townships and I think two or three state rights.
>
> "X-Q. 91. Were those sales made in written deeds or instruments or simply verbally?
>
> "A. They are what would be called a written instrument, partly printed and partly written."

From the above it appears that territorial rights or licenses for counties, townships and "two or three states" have been sold under the Kitselman patent. These licenses or territorial rights were conveyed by written instruments. In some cases they conveyed the three rights —to make, sell and use. They were *exclusive* of the complainants as well as others. According to the admissions of Mr. Kitselman, the complainants ceased, therefore, to have any rights in the territory sold. Such rights belonged wholly to the licensees.

Under repeated decisions of this court the conveyance in writing of a territorial right or license, including the right to *make, sell* and *use* the invention, operates as an assignment. To cite a single case—

In *Waterman* v. *MacKenzie,* 138 U. S., the Supreme Court said:

> "The patentee or his assigns may, by instrument in writing, assign, grant and convey, either, 1st, the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or, 2d, an undivided part or share of that exclusive right; 3d, the exclusive right under the patent within and throughout a specified part of the United

States. Rev. Stat. Sec. 4898. A transfer of either of these three kinds of interests is an assignment, properly speaking, and vests in the assignee a title in so much of the patent itself, with a right to sue infringers; in the second case, jointly with the assignor; in the first and third cases, in the name of the assignee alone."

Under the above decision and others of like purport the deeds or instruments which the complainants admit that they gave in this case conveying the exclusive right to make, sell and use the invention of the Kitselman patent for certain townships and counties and two or three states, operated as assignments and fell within the third class of assignments enumerated by the court above. The owners of these townships, counties or states are entitled to sue for infringements alone and without joining the complainants. Anybody infringing the patent in their territory is amenable to them alone. The complainants have no interest in the matter, are not damaged, have no right to complain. They cannot sue for such infringements because they have no title to the Kitselman patent in the territory where they are committed.

The complainants have not introduced the deeds showing the territory parted with by these sales, nor have they shown that these sales *did not include the very territory where the defendants have been manufacturing and selling.* The only testimony in the Record to show where the defendants have been manufacturing and selling the alleged infringing machine will be found on page 32 of the Record, where, in response to a question by complainants' counsel, to avoid the calling of witnesses, the defendants' counsel, after consultation with Mr. Frederick, one of the defendants, admitted that machines like the defendants' machine,

offered in evidence by complainants as "Complainants' Exhibit Defendants' Machine," *were being made and sold at Kokomo, Indiana.*. Kokomo, Indiana, is in Howard County, Indiana. There is no proof in the Record that the defendants have ever manufactured or sold a single machine *outside of Howard County, Indiana,* but Howard County, Indiana, may have been *one of the counties* that the complainants have sold under the Kitselman patent. It is for the complainants to show *affirmatively* that they own the territory where the alleged infringements occurred. They have stated that they had sold *various* counties and states under the patent, and that they were sold by written instruments. These written instruments may never have been put on record. The defendants have no knowledge of the purchasers of these counties and states. They do not know where to find them. They have no means of procuring copies of the deeds or instruments, if they have not been put on record. The complainants, however, must know to whom they have sold territory *and the territory that they have sold.* They should have shown *affirmatively* that they had not *parted with the territory* in which the alleged infringing acts occurred.

When they had introduced the patent issued to themselves they showed a *prima facie* ownership of the *entire* country—they had made out a *prima facie* case as to title. They have *destroyed* that *prima facie* case, however, by admitting that they did not own *as much* territory as the patent on its face covered. They admit that they have sold *some* of the territory, some townships, some counties, some states. This admission destroyed their *prima facie* case as to title. After such admission they should have affirmatively shown that such sales of territory *did not cover* the territory where the alleged infringing acts were taking place

—or rather that, notwithstanding such sales, they still owned such territory. Such affirmative testimony was necessary to *restore* their *prima facie* case.

The presumption of law is that the defendants are not doing anything that they do *not have the legal right to do;* that their acts are *lawful.* When, therefore, a complainant admits that he owns only a part of the territory of the United States under his patent, but fails to specify the particular part that he does own, the *presumption of innocence* just suggested will cause the court to presume that the acts complained of were in the territory *not owned by the complainant,* as otherwise the court would have to presume that the defendants were guilty; that they were manufacturing and selling unlawfully; that they were operating in territory belonging to the complainant and where they had no right. When complainant shows that his interest has been *severed* he must, in order to recover against a particular defendant for infringement committed at a particular place, show that such place is in the territory *still owned* by him. The complainants have failed to do this.

In the state of the proof as left by the complainants and for the reasons suggested above, we must submit and insist that the complainants cannot recover, because they have failed to show *title* to the *particular territory* where the defendants' alleged infringing acts have taken place.

2. *The Second Question Presented.*—Where it was old to make *one* style of fencing with a portable field machine, can a portable field machine for making *another* style of fencing—such *other* style of fencing *being old*—be considered as a pioneer machine?

The United States Circuit Court of Appeals fell into a mistake of fact and law in holding that the Kitselman patent was a pioneer patent, considered with reference to field machines, and entitled to the liberal consideration accorded to such patents.

a. The Kitselman patent on its face describes a machine applicable for either *stationary or field work*, but whether built in the one form or the other it was the same *machine*, the same *apparatus*. In the second column of the first page the specification says that "*when* the *apparatus* is to be constructed in portable form" it is to be made so and so. Still, however made, it is the same *apparatus*. The specification proceeds to describe with great minuteness the details of construction, and then just before the claims says:

> "I may either construct a portable machine, as shown in the accompanying drawing, to work in the open field or other place, or dispose the parts in a horizontal instead of a vertical position and mount the same on suitable bearings and legs to provide a stationary machine for indoor use."

It thus appears that it is the *same* machine, but is *vertically* disposed when used as a *field* machine and *horizontally* disposed when used as a *stationary* machine. No distinction is drawn between the machine *as a machine*, whether employed in the *one* method or the other. The *two methods* of use are treated as *equivalents*. No importance or stress can, therefore, properly be laid on the fact that the machine is usable as a field machine.

b. The Kitselman patent was also intended to build, among other things, a combined wire and picket fence *the same as built* by the Fultz 1884 patent or the Middaugh &

Wilcox 1884 patent, as will appear from a comparison of Fig. 19 of the Kitselman patent, Fig. 1 of the Fultz patent, p. 651, and Fig. 2 of the Middaugh & Wilcox patent, p. 665. The Kitselman patent was, therefore, intended as a field machine to do *the same work* that was done by the prior patents. Hence it made those patents, capable of making *certain* kinds of fence, full anticipations of its machine as a field machine for making *similar* kinds of fence.

c. The only claim presented in the Patent Office for a field machine was the original nineteenth claim, printed at page 481 of the Record, which read:

> "19. In a wire fabric machine, the combination of a track, a carrying frame geared to the track and having the twisting devices and the wires, and pawl and ratchet mechanism for feeding the frame and its devices, substantially as described, for the purpose set forth."

This claim was rejected on the Fultz and other patents, and the rejection was acquiesced in and the claim withdrawn.

This rejection and acquiescence forever precluded Kitselman from claiming novelty for his construction *as a field machine,* much less a *pioneer* character for it.

In *Morgan Envelope Co.* v. *Albany Paper Co.,* 152 U. S., 429, the Supreme Court said:

> "The patentee having once presented his claim in that form, and the patent office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim or *such a construction of his present claim* as would be equivalent thereto."

The doctrine of the above case was approved and reaffirmed by the Supreme Court as late as last December—

during the present term of the court—in *Hubbell* v. *United States,* 179 U. S., 80, where the court say:

> "An examination of the history of the appellants' claim, as disclosed in the file-wrapper and contents, shows that in order to get his patent he was compelled to accept one with a narrower claim than that contained in his original application; and it is well settled that the claim as allowed must be read and interpreted with reference to the *rejected* claim and to the prior state of the art, and cannot be so *construed* as to cover either *what was rejected by the patent office* or disclosed by prior devices."

Nor can the court consider whether such rejection was well or ill-founded, nor whether the Examiner was right or wrong in his decision. The decision being made, the rejection being acquiesced in and no appeal taken, the matter is considered as fixed and settled.

In *Hubbell* v. *United States,* 179 U. S., 83, the Supreme Court, in considering the effect of an Examiner's decision and rejection and acquiescence therein by the applicant, said:

> "Whether the examiners were *right* or *wrong* in so holding *we are not to inquire,* as the claimant did not appeal, but amended his claim and accepted a grant thereof; thereby putting himself within the range of the authorities which hold that if the claim to a combination be restricted to specific elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be *strictly* construed *against* the inventor and in *favor* of the public, and looked upon as in the nature of disclaimers."

When, therefore, Kitselman presented a claim for a field machine and such claim was rejected on the Fultz and other patents and he failed to appeal and acquiesced in the rejec-

tion and withdrew his claim, he precluded himself, under the authorities above quoted, and their number could be indefinitely increased, from claiming a *construction in court* which protected his machine distinctively *as a field machine*, much less as a *pioneer* field machine.

d. The claims relied on are not for combinations *specifically required* for a field machine, but for combinations that are *equally adapted* for a stationary machine. They have no *special applicability* to the one form of machine or the other. They cannot, therefore, be considered as giving *distinctive* character to the machine as a *field* machine. In discussing this defendants' expert, Mr. Wiles, on page 193 of the Record, says:

> "The second patent in suit, No. 356,322, issued January 18, 1887, to Alva L. Kitselman, is for Improvements in Wire Fabric Machines, and shows and describes a machine adapted for use in the field, as distinguished from machines of the loom type like those of Davisson and Nesmith. There is, however, no claim of the patent relating to a field machine, as distinguished from a loom; and the fact that the Kitselman machine is a field machine is therefore wholly immaterial, and any comment on the fact is entirely irrelevant to this suit. Furthermore, Kitselman was not the originator of the idea of a field machine for building wire fence in the field. A well known form of fencing made long before Kitselman's invention was that in which longitudinal pairs of wires were intertwisted, with vertical slats or pickets inserted between the twists at suitable intervals; and Kitselman states in his specifications that his machine is adapted to make such fencing, the structure of the fence itself being illustrated in Fig. 19 of the drawings of the Kitselman patent. This fencing was made on stationary machines, or looms, such, for instance, as that shown in U. S. patent No. 312,063, issued to George C. Adams, February 10, 1885, for Improvements in Fence Making Machines; and machines adapted to

make such fencing in the field are shown in various patents prior to the Kitselman patent, as, for instance, in U. S. patent No. 298,368, issued May 13, 1884, to John M. Fultz, for Improvements in Upright Wire-fence-making machines, U. S. patent No. 309,724, issued December 23, 1884, to Middaugh & Wilcox for Portable Fence Machine, and U. S. patent No. 347,064, issued August 10, 1886, to William H. Reppeto, for Improvements in Wire-fence Machines. In the use of all these portable machines, or field machines, the longitudinal wires were stretched between suitable supports in the field and passed through tubes or spindles in the frame of each machine, the machine in every case being moved along the wires as the fence was formed. The step of change or improvement from the stationary or loom machine to the movable field machine having been taken in the manufacture of one form of wire fencing, there was evidently no invention in the mere change from the loom to the field machine in the manufacture of the other well-known form of wire fencing. Furthermore, as may be seen by examining anyone of the three patents just referred to, the field machines for making wire and slat fencing have the same characteristics adapting them to use in the field which are found in the Kitselman machine or any of these other field machines for making diamond-mesh fencing. Each of them has a vertical frame supporting its working parts, the frame being provided with means for moving it readily along the line of fence and being adapted to permit the passage through it of the longitudinal wires of the fence. The operating parts were adapted for the manufacture of the particular fencing which the machines were intended to make."

In fact, the complainants' expert, Mr. Dayton, admitted that, so far as the *essentials* of the four patents sued on are concerned, it is *immaterial* whether they are embodied in a *portable* machine or a *stationary* machine. On page 82 of the Record Mr. Dayton testified:

"X-Q. 37. To sum up the results of our study of

these patents to this point, I will ask you if it is your opinion that the *essentials* of the inventions described in the several claims selected for the purpose of this suit, from the patents sued on, are dependent on their use in a *stationary* or *portable* machine, or in a power or hand machine, or upon their capacity to weave a fabric in which slats or palings may or may not be used, or upon their capacity to weave a fabric of any special size of mesh?

"A. All these questions have been already answered, and referring to the explanation made in the preceding answers to them, I here reply to them as a group by saying that, in my opinion, the *essentials* of the inventions described in the several claims here in suit are not dependent on their use in a *stationary* or *portable* machine, or in a power or hand machine, or upon their capacity to weave a fabric in which slats may or may not be used, or upon their capacity to weave a fabric of any special size of mesh."

e. The only novelty that the Kitselman machine can be said to have rests in the *means* for weaving the fabric. The *fabric* itself was old in the Davisson patent, to mention no others. Portable or field machines were also old. The opinion of the court concedes that portable or field machines, *broadly considered,* were old, as in the Middaugh & Wilcox patent, to mention no others. The Kitselman machine and the Middaugh & Wilcox machine, however, made *different kinds* of fabrics—the Kitselman a diamond-mesh *and* a wire and picket fence (see Figs. 11 and 19) and the Middaugh & Wilcox machine a wire and picket fence—both *old* kinds of fabric.

If the Kitselman machine be used as a portable machine to make a *diamond*-mesh fence it would make an *old* style of fabric; if used to make a *wire and picket* fence it would make an *old* kind of fabric. No novelty can, therefore, be

imported into the Kitselman machine, *on account of the fabric woven.* In this state of things the only thing that Kitselman can be held to have done was to set his machine *up on end* like the Middaugh & Wilcox machine and use his mechanism to weave the same old fabric while the machine was in a *standing* position. This is what he did and all that he did to *convert* it from a stationary to a portable machine. He simply set it on end and mounted it on a truck, but made no change in the *mechanism.* The *mechanism* was the *same* and the *operation* was the *same,* whether the machine *was lying down or standing up.* As already quoted from the specification, *all* that was *necessary* to convert the machine from a portable machine to a stationary one was to "*dispose* the parts in a *horizontal* instead of a *vertical* position and mount the same on suitable bearings and legs to provide a stationary machine for in door use," and all that was necessary to convert it back again was to stand it up on end. Whether lying down or standing up it was the *same machine,* the same *structure,* the same *mechanism.* But with portable machines *already* in the field making fence of *one* kind, we submit that there was no invention required in mounting a machine which made a fence of *another* kind on a truck and using it also in the field. Such *conversion* from one form of machine to the other ought not to be called an *invention,* much less a *pioneer* invention.

But if Kitselman was entitled to a pioneer patent over Middaugh & Wilcox because his machine produced a *different* kind of fabric, then the next man that comes along with a stationary machine for producing a different kind of fabric from Kitselman will also be entitled to put it on a truck, make it a *portable* machine and call *it a pioneer patent,* be-

cause it makes a *different* kind of fabric from the kind made by Kitselman, just as the majority of the court has considered the Kitselman patent as a pioneer one because its fabric differed from the fabric of the machine of Middaugh & Wilcox. We submit that the logic of the majority of the court leads to such a position, but that it is untenable.

3. *The Third Question Presented.*—Even if the Kitselman patent be considered as a pioneer patent for a field machine, the defendant's machine is so widely different from it in mechanism and mode of operation that it cannot be considered an infringement.

The majority of the Circuit Court of Appeals has fallen into error in the application of the law in relation to pioneer patents. A pioneer patent does not cover *all forms* of machines for producing the same *result,* but only those machines which produce the same result in substantially the same way and with substantially the same mechanism. The *mechanical means* employed by the defendant may be so different from those employed in the pioneer patent that there can be no infringement. The decision of the majority of the court seems to lose sight of the fact that, even though the Kitselman patent be a pioneer one, the defendants *are at liberty* to devise and use *other forms* of mechanism for producing the *same result* without infringing it. Even if the Kitselman patent be a pioneer patent it cannot cover *every combination* of devices for producing the same thing.

In *Westinghouse* v. *Boyden Power Brake Co.,* 170 U. S., 569, the Supreme Court, in considering a patent which they held to be a pioneer, said:

> "*Even if* the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the *same result*. He must have reached it by *substantially the same or similar means*, or the rule that the *function* of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent its function. . . .
>
> "Conceding that the *functions* of the two devices are *practically the same*, the *means* used in accomplishing this function are so *different* that we find it impossible to say, *even in favor of a primary patent*, that they are mechanical equivalents."

A number of decisions could be cited to the same end, but we regard the above late expression of the Supreme Court as sufficient.

While it is contended on the part of the petitioner that the Kitselman patent is not to be considered as a pioneer patent for a field machine, but merely a patent covering the specific improvements, yet, however it may be considered, it is insisted on behalf of the petitioner that it is not infringed by the widely different means and mode of operation employed in the defendant's machine. This necessitates a consideration of the Kitselman invention and a comparison with it of the defendant's machine.

The particular claims of the Kitselman patent held to be infringed under the majority opinion of the Circuit Court of Appeals are the first, second, eleventh and fifteenth. These claims are as follows:

> "1. In a wire-fabric machine, a series of sectional twisters, each of which comprises a central section for carrying a warp-wire, and having rotary movement imparted thereto, and the shifting sections for

carrying the weft-wire, and receiving rotary motion from the central section to form the twist, substantially as and for the purpose herein described.

"2. In a wire-fabric machine, the combination of a series of sectional twisters geared together for simultaneous rotation, and each comprising a central portion movable on its axis and side portions capable of a compound movement—that of rotation on their axes—and of a shifting longitudinal movement, substantially as described, for the purpose set forth.

"11. In a wire-fabric machine, a series of twisters connected for simultaneous operation, and each consisting of a central section and the side section, in combination with the spools carried by the side sections, the central section of each twister being provided with a longitudinal opening for the passage therethrough of the warp-wire, substantially as described.

"15. In a wire-fabric machine, the combination of a series of rotary twisters geared directly together for simultaneous operation, each twister having a central section capable of rotary movement only, and two side sections which are capable of a shifting movement independently of the central section in opposite directions simultaneously, whereby the said shifting sections of one twister are adjusted to register with the central sections of twisters on opposite sides of the same, substantially as described, for the purpose set forth."

The prominent feature of all these claims is the *sectional* twister. Sectional twisters appear as an element in each of the claims sued on, although somewhat different terminology is employed in the different claims to designate them. In some of the claims they are spoken of as "a series of sectional twisters;" in others as a "series of twisters," and in others as "a series of rotary twisters." They are, however, the same mechanical elements under whatever different names they may be designated in the claims. In cross-question 72 on page 94

of the Record, Mr. Dayton, the complainants' expert, said "that the terms 'sectional twisters,' 'twisters' and 'rotary twisters,' used in the several claims under consideration refer to the same three-part twister devices." We may, therefore, consider that all of the claims of the Kitselman patent in suit call for "three-part twister devices" in the various designations under which the twisters are called for. The combination or structure, therefore, called for in the claims of the Kitselman patent relied on is one in which three-part twister devices form a prominent and distinguishing element or characteristic. With these preliminary remarks we are prepared to take up and consider the Kitselman machine of the claims of his patent sued on.

By turning to the drawings of the patent and looking at Fig. 1, we will perhaps get the best general idea of the Kitselman machine embodied in portable or field form. This drawing presents the machine to us as it would appear to the eye when we were standing by its side looking at it performing its work in the field. Thus looking at the machine we see the edges of three vertical boards held together by cross-pieces forming the frame of the machine in which the various parts are mounted and maintained. The rear frame board—the one at the right hand—contains the crank by which motion is imparted to the working parts of the machine. We see arranged between the rear board and the one next to it a series of hollow spindles or tubes, on which a series of gear-wheels are rigidly mounted to rotate the spindles as they are rotated by the turning of the crank. These hollow spindles or tubes project forward through the middle vertical board, after which they are represented as flattened out instead of being round, and as provided at each end between the middle board and the front one with laterally-projecting cross-pieces. This will be readily un-

derstood by looking at Fig. 4, where the machine is sawed in two from top to bottom, bisecting the various parts. A still clearer view of this perforated tube or spindle will be got by looking at Fig. 7, where it is shown detached and as the *central* one of the three pieces shown in such figure. The holes through the center of the spindles are intended to permit the passage of intermediate longitudinal tension or warp-wires. This peculiarly shaped *central* perforated tube or spindle is *one* of the members of the three-part twisters. It is, however, *but* one of the members and is useless and inoperative until complemented and supplemented by two *side* sections, which are illustrated in detail and as detached in Fig. 7. In this figure we see the side sections ready to be moved up against the central section to form the complete three-part twister. These *side* sections are intended to receive and carry the spools containing the weft-wire to be twisted into the meshes. *Without* them there would be *no support* provided for the weft-wire spools. When they are moved up against the central section their laterally projecting segmental shaped end pieces will be found to be parts of circles corresponding to that contained in the end pieces of the central spindle or tube. Together they form *circles or wheels* journaled or supported in suitable bearings in *sliding* bars arranged between the two forward vertical frame boards of the machine. In performing their work these *side* sections are intended to *slide* alternately up and down—play back and forth—from one central perforated spindle to the next adjacent one. They are intended to be shifted by a *direct lateral* movement, pushing or pulling them up and down, back and forth, so that part of the time a given side section is in conjunction with one central spindle, and part of the time in conjunction with the next adjacent one. The sliding bars supporting them can be slid up and down by means of a

lever to push and pull these side sections up and down in effecting their connection and conjunction with one spindle or another. These sliding bars are connected at the top of the machine by a walking-beam, to use the mechanical term, projecting at one end into a lever, so that they move in unison, one moving up as the other moves down. These sliding bars and their method of operation will be readily understood from an examination of Figs. 5 and 6 of the drawing, where they are illustrated as one up and the other down, the one that is up in Fig. 5 being down in Fig. 6 and *vice versa*.

From the above examination and analysis of the Kitselman machine it will be apparent that one of the most prominent and important features contained in it, as already suggested, is the *three-part* sectional twister. This three-part twister, to again suggest its peculiarities, has its *central* part *rotary*, but not capable of movement up or down, while it has its two *side* parts movable up and down alternately to make connection with the central part of the adjacent twisters. The central part is *flat* and provided with *projecting* end pieces, and the side pieces are flat on the inside and are provided with *heads* in the form of *segments* of circles, so that when they are brought into contact with the central pieces the heads form *wheels* or circles. The side pieces carry the spools on which the weft-wire is wound, so that as they are moved up or down they carry the spools with them and thus permit the twisting of the diamond-mesh fabric. Means must necessarily be understood as present for *imparting rotation to* the hollow spindles and thereby to the complete and assembled twisters, as otherwise the machine could not be operative. Means must also be understood as present in the machine for *sliding* the segmental or side portions of the twisters *up and down* at the

will of the operator to effect the shifting of the twisters, as otherwise the machine could not do its work. The claims in suit, therefore, cover a structure in which there are necessarily present hollow spindles, means for rotating the spindles, a portion of the spindles *flat* with *laterally*-projecting heads, two *side* sections to complement and supplement each spindle, provided with segmental heads to *match* the *flat* central pieces and form the three-part twisters, spools mounted on the segmental side sections of the twisters and means for shifting or moving the side sections of the twisters up and down in a *direct right line* to effect the shifting of the spools from one twister to another.

Kitselman was not the first to show or describe split or divided twisters. The Whitehead 1854 British patent, Record, 772, introduced as a printed *publication*, describes and shows split or divided twisters in which the two halves of the twisters are shiftable or movable up and down to cross the wires and make the diamond mesh. This is well illustrated in the drawings of the British patent at page 778 of the Record. This British patent also shows and describes means for moving or shifting the two parts of the twister up and down to effect their change of positions whenever the operator desires. This Whitehead British patent, however, does not show or describe a *three*-part twister in which the central part is *flat* and provided with *projecting ends* to permit the segmental parts of the twister to be brought into such position that they make *wheels* at the ends to permit the twister to be journaled at each end.

The Smith British printed provisional specification of 1876, at page 790 of the Record, clearly describes a *three*-part twister like that shown and described in the Kitsel-

man patent. This British patent is not provided with drawings and was never carried further than a provisional specification. This, however, was *printed,* and so forms a *printed publication,* which, under the statute, is as good for purposes of reference and defense as are patents. The language of this British printed publication is very plain and intelligible to any one, whether he be a mechanic or not. It first describes a two-part twister and then describes a three-part twister, exactly like that of the Kitselman patent. We will quote the portion of the publication that describes these twisters:

> "I apply to the lower part of the machine feeding bobbins, supplied with the wires or cables, which pass up to the work in suitable guides, and I cut a space out of the center of one of the halves of the twisting wheels (which are always made in two parts) so that my wires shall pass through; then when the divisions of the wheels are carried apart by the ordinary sliding bars my wires are pushed up by guides out of the spaces in the wheels into slots in one of the sliding bars about mid-way between the turning wheels and on the opposite side of its half-wheel, so that my wire may be held while the twist is made, and they are thus relieved from the action of the twisting wires which form the mesh. Or I divide the twisting wheels into *three* parts, my extra wire passing through the *central* division, and the two *side segments* travel to and fro to form the twist, leaving the central division in position with my supplementary wire therein maintained."

The language descriptive of the three-part twister is exactly applicable to the Kitselman twister. There is no misunderstanding its meaning. It is useless for complainants' experts to ridicule its brevity or claim that it is too meagre, indefinite and general to convey to mechanics skilled in the art, and who have a knowledge of the two-part

twister of the Whitehead 1854 British patent, or the three-part twister of the Nesmith patent, a sufficient and definite knowledge of how to make a three-part twister like that of the Kitselman patent, in view of the Whitehead and Smith British printed publications.

These British publications were referred to by the Examiner when the Kitselman application was pending in the Office, and Kitselman made many changes and modifications in his claims in order to avoid them and other references. By turning to page 478 of the Record we will find the claims as Kitselman *originally* presented them to the Office. The first claim, as originally presented, called for "a series of sectional twisters geared directly together." The second claim called for "a series of sectional twisters capable of sliding movement with relation to each other and geared for simultaneous rotation." The third claim called for "the series of sectional twisters comprising the central hub section and the two side sections disposed on opposite sides of the central section, the hub section being stationary, while the side sections are capable of shifting movement." The fourth claim called for "the series of sectional twisters, each of which comprises a longitudinal immovable section and two sections which have longitudinal movement." The fifth claim called for "the series of sectional twisters, each of which comprises the central portion carrying the warp-wires and the shifting side sections which carry the weft-wires."

We have referred to these five claims as they were originally presented to show that the sectional twisters were *claimed broadly* and in various forms of language. By reference to pages 479 and 480 of the Record the court will see other claims that were originally presented and which

were afterwards erased, in which the sectional twisters also form the prominent and principal features.

By reference to the letter from the Office printed on pages 483-4 of the Record it will appear that the first and second claims, among others, were rejected on certain patents mentioned.

Thereupon, as will appear from the letter by Kitselman to the Office printed on page 484 *et seq.* of the Record, claims 1 and 2 were erased and others substituted in their place. Claim 1, as substituted, called for "a series of rotary twisters geared directly together for simultaneous rotation, each having two sections which are capable of a sliding movement." Claim 2, as substituted, called for "the combination of a series of rotary twisters geared directly together."

Thereupon, as appears from page 488 of the Record, the Office wrote again rejecting substitute claims 1 and 2 and citing the Nesmith 1854 patent as grounds for the rejection.

In response to this letter, as appears from page 489 of the Record, Kitselman withdrew substitute claims 1 and 2 and changed the numbers of original claims 3, 4 and 5, already quoted, to 1, 2 and 3 and made corresponding changes in the numbers of the other claims.

After further examination, as appears from the letter of the Office printed on page 492 of the Record, the Office discovered the Smith British printed publication of 1876, describing the split or divided twisters, from which we have

already quoted, and on the strength of it rejected claims 1, 2 and 3, which we have already quoted as original claims 3, 4 and 5.

Thereupon, as appears from page 493 of the Record, Kitselman also withdrew these claims 1, 2 and 3, original claims 3, 4 and 5 and substituted claims 1 and 2 as they now stand.

It thus appears that the first five claims, which we have already referred to and which broadly claimed the split or divided twisters, were rejected on various patents, and that *three* of them were rejected on the Smith British provisional specification, which we have introduced as a printed publication, and that Kitselman acquiesced in such rejections and withdrew his claims for the split or divided twisters *broadly*.

The law is well settled that where a party makes a claim for a mechanism broadly and such claim is rejected upon references, and he acquiesces in the rejection and withdraws his claim in order to get his patent, he is thereafter forever precluded from putting a construction upon the claims allowed him which would make them mean the same thing or substantially the same thing as the claim which he has once presented and afterwards withdrawn.

In view of these proceedings in the Office, irrespective of the language of the claims themselves, it is apparent that the claims of the Kitselman patent sued on must be limited in their scope to the actual combination of the essential parts found in the Kitselman machine, combined as shown and described and operating as shown and described. They cannot, in consonance with legal principles, be construed to

cover *other* combinations which, although effecting the same general results, are made up of elements of different construction and arrangement from those found in the Kitselman machine.

An examination and study of the claims of the Kitselman patent sued on show that they are drawn to *aptly describe* the Kitselman construction *just as it is represented* and described in the drawings and specification. In all of the claims are to be found, called for and required the *three*-part twister, the central part being *flattened* and provided with laterally-projecting cross-pieces at the ends, and the side pieces being *flattened* on their *inner* sides and provided with *segments* of circles at each of their ends, so that the completed twister will be provided with *wheels* at each of its ends, which lie in suitable openings in the sliding bars to support the twister. In addition to this, the side pieces are capable of being shifted, and by the construction and arrangement shown they must be shifted *laterally* in a *direct* line from one central hub to the next adjacent. In addition to this there must be the *sliding bars* capable of engaging the segmental ends of the side pieces and shifting them up and down. All of the claims of the Kitselman patent sued on must be held to be *limited* by their language, by the prior art and by the proceedings in the Patent Office to the combinations of the specific elements shown and described in the Kitselman patent—that is, to the specific construction of the twisters of the Kitselman machine and their associated parts. To attempt to give the claims a broad construction will cause them to be met by the Davisson and Nesmith patents.

It appears that Kitselman took out a Canadian patent which was as to its drawings, specifications and claims substantially, not to say literally, a copy of the Kitselman patent sued on, as is admitted by complainants at page 242 of the Record. This Canadian patent was involved in litigation in Canada. A party named Cochrane was manufacturing a fencing machine in Canada and a party named Risdon, who owned the Kitselman Canadian patent, commenced suit against him at St. Thomas for infringement. Kitselman was a witness in this suit in behalf of his own patent. (Record, page 450.) The matter was argued before Chancellor Boyd at St. Thomas, and his decision was announced October 18, 1892. The court will find it printed beginning at page 162 of the Record. Chancellor Boyd held that there was no infringement. He held that the Kitselman machine "is not a *new* machine," but merely a "new adjustment of parts to accomplish a *given* result." Among other things, in speaking of the Canadian Kitselman patent, being a duplication of the patent sued on, Chancellor Boyd on page 163 of the Record said:

> "It is a patent for a combination, and one of the difficulties in such patents is that any person with skill making a different combination, which is either materially or esentially different, or which produces the same result by a simplification of the parts, is able to hold his ground against the combination. The essence of an infringement of a combined patent is a repetition of the parts of that patent. It may be that if merely colorable changes are made a person would not escape the penalties of such an infringement. But if they are something more than colorable variations then the particular combination of parts is not infringed. The patent consists in the particular combination."

From this quotation from Chancellor Boyd's opinion it will appear that the principles applicable to combination

patents are the same under the Canadian law as in this country. A patent for a combination must be limited to the combination *claimed.*

Applying this principle, Chancellor Boyd held that the Kitselman patent was a limited combination patent that must be confined *strictly* to the particular parts and elements claimed; and that, therefore, there was no infringement by the defendants' machine.

The defendants' machine is fully described and claimed in the Whitney patent No. 552,025, issued December 24, 1895 to W. D. Whitney, Record, 767, under which the defendants are licensed and through which they justify. When we turn to this patent and to the defendants' machine we find it entirely different in appearance from the machine of the Kitselman patent sued on. Its external dimensions and simplicity strike the eye and arouse the mind. It is so different from the machine of the Kitselman patent in suit or of the prior art that the mind instinctively feels that it contains and embodies invention. To look at the defendants' machine and then to be told that it is the Kitselman machine excites doubt and incredulity. When we come to compare them point by point the differences appear so striking, so essential, and the similarities so faint, so far fetched, that the skepticism excited at the first grows into a fixed convicition that the two machines have nothing in common that either can claim.

Structurally the defendants' machine comprises a single vertical upright bar or support; a series of hollow tubes fixed *rigidly* and *non-rotatably* in such vertical support; a series of intermeshing, rotatable gears mounted *loosely* on

the stationary hollow tubes as journals and arranged next to the upright support and provided with two forwardly projecting rigid studs at the opposite sides of their axes or centers; a set of plates *loosely* surrounding and journaled on the hollow tubes with a space of about one-half inch between them and the gears and connected rigidly to and rotating with the intermeshing gears and provided with two rearwardly projecting spring pins or studs at opposite sides of their axes or centers and disposed at the distance of about an inch and a quarter from the rigid forwardly projecting studs on the gears; a set of spool-carriers each mounted on a plate having inclined notches at the diagonal corners on one side and inclined grooves at the opposite diagonal corners on the other side, so that when one side of the plate is inserted between a gear and its plate one of the rigid studs may pass along a groove on one side and a spring pin or stud pass into and catch against the notch on the opposite side and thus retain and support the spool-carrier as long as the parts are rotated in the same direction, whether it be a minute, an hour or a day; spools for the woof wires mounted in the spool-carriers; and of course means for imparting rotation to the intermeshing gears. When it is desired to transfer the spool-carriers the parts are rotated until the carriers are between the stationary spindles, when the direction of rotation is *reversed*. This causes a spring pin and a rigid stud on the adjacent gear to enter the empty or unoccupied groove and notch in the carrier-plate and to lift it out of connection with the gear-plate with which it had been rotating and to carry it around in its new position or relation as long as rotation is continued in that direction. When it is desired to shift it again to bring it into relation with another gear and plate the direction of rotation is again reversed. This is kept up as long as the machine is in operation.

In considering the question of the infringement of the Kitselman patent we asked the complainant's leading expert, Mr. Dayton, a number of specific questions to bring out the differences between the Kitselman machine, as described and claimed in his patent, and the defendants' machine, and he was obliged to admit the existence of many important and, as we view them, conclusive differences between the two machines. We will quote the questions and answers bringing out these points of difference so that the court may find them convenient for reference and examination. We begin the quotations on page 99 of the Record:

"X. Q. 91. In the machine, described in the claims of the Kitselman patent sued on, the central spindle rotates, while in the defendant's machine the central spindle is stationary. Is not this correct?

"A. As already stated in my former answer to precisely the same question, the spindles shown in the Kitselman patent and, of course, embraced in the claims in suit, rotate along with the pinion portion of the same central section, and in defendant's machine the spindle portions of the central sections do not rotate, and only the gear and cross-head portions of said sections do rotate. . . .

"X. Q. 93. I ask you if the gears or pinions in the Kitselman machine are not fast with the central spindles, while in the defendant's machine they are loosely mounted on such spindles. Is not this correct?

"A. Now, understanding that by the Kitselman machine is meant the Kitselman machine as illustrated in the drawings of the Kitselman patent in suit and as embodied in the complainants' exhibit Kitselman machine No. 1, which corresponds with the patent, I reply that in such illustration and embodiment of the Kitselman machine the gears or pinions are fast with the central spindles and that in defendant's machine the gears or pinions are loosely mounted on such spindles.

"X. Q. 95. In the Kitselman machine the side sections or spool carrying frames and spools on the re-

spective sides of the central spindles are mounted on a common bar, and are shifted by a hand lever, while in defendant's machine the spool carrying frames and spools on the opposite sides of the central spindles are separate and independent and not mounted on a common member, and are not shifted by a hand lever. Is not this correct?

"A. In defendant's machine the shifting sections of the various twisters are not shifted by a hand lever, but automatically and independently by shifting mechanism. . . .

"X. Q. 96. In the Kitselman machine, the side sections on the opposite sides of the central frames are moved or shifted by a sliding movement directly up and down, while in the defendant's machine the spool carrier frames and spools are shifted by a rotary movement. Is not this correct?

"A. In defendant's machine the side sections are shifted to an upper or lower twister in a rotary movement of the twisters, while in the Kitselman machine they are shifted up and down in the absence of rotary movement.

"X. Q. 97. In the Kitselman machine the side sections require and are provided with means for supporting them at each end, and if either end were unsupported by such means, the side sections would drop out, while in defendant's machine the side sections require and are only provided with means for supporting them at one end. Is not this correct?

"A. It is. . . .

"X. Q. 99. In the Kitselman machine the side sections could be lifted out and re-inserted end for end so as to operate by providing another hole for the woof wire to pass out, while in the defendant's machine the side sections could not be lifted out and re-inserted end for end without practically reconstructing them. Is not this correct?

"A. The side sections of defendant's machine can be lifted out with greater ease than the side sections can be removed in the Kitselman machine. In the Kitselman machine No. 1, the semi-circular end portions of the spool frame, being substantially alike ex-

cept that one is perforated to deliver the spool wire, while the other is not, this spool frame could be changed end for end and, with a hole made in the now imperforate end, it would deliver the wire in that position. . . .

"X. Q. 100. In the Kitselman machine, as illustrated and described in the patent and as embodied in the full size machine before us, it is necessary that the central spindles or sections shall rotate in order to have an operative machine, while in defendant's machine it is not necessary that the central spindles should rotate. Is not this correct?

"A. In the exact construction shown in the Kitselman patent and embodied in this Kitselman machine No. 1, it is necessary that the spindles shall rotate, and in defendant's machine it is not necessary that the spindles should rotate. . . .

"X. Q. 101. In the Kitselman machine, as illustrated and described in his patent and as embodied in the full size machine before us—Kitselman machine No. 1—we would destroy the operativeness of the machine if we were to make the hollow central spindles stationary instead of rotative, while in the defendant's machine we would not destroy its operativeness by making the hollow spindles rotative instead of stationary. Is not this correct?

"A. By reason of the fact that in the Kitselman machine, wherein the spindle does rotate, the engagement for carrying around the spool frames or side sections is made with the spindles and not with the gears, it is true that in this Kitselman machine, if these spindles were to be made secure against rotation, the machine would not be operative. In defendant's machine, on the other hand, the spindles could be made to rotate with their own gears operatively, if only suitable bearings were provided between the spindles and the frames where now these have rigid connections.

"X. Q. 102. If we transferred the side sections or spool carrying frames and spools from the defendant's machine into the Kitselman machine, or transferred the side sections or spool carrying frames and spools from the Kitselman machine into the defend-

ant's machine, would we not have an inoperative machine?

"A. The parts would not fit and the machine would not operate.

"X. Q. 103. If we transferred the central sections, so called, of the defendant's machine into the Kitselman machine, or the central sections of the Kitselman machine into the defendant's machine, would we not have an inoperative machine?

"A. This is practically the same question as the last, and I reply that the parts would not fit, not being made interchangeable, and the machines would not operate.

"X. Q. 104. If the shifting devices were transferred from the Kitselman machine to the defendant's machine, or the shifting devices of the defendant's machine transferred to the Kitselman machine, would we have an operative machine?

"A. The parts referred to are not interchangeable and we would not have an operative machine."

From the foregoing it is apparent that the Kitselman patented machine and the defendants' machine differ from each other in a number of important and essential features of construction and operation.

In the Kitselman machine the spool-carriers are shifted from one section to another by being *slid or moved in a direct* line or *straight* path, while in the defendants' machine this is not the case, as they have to be *rotated* through a *curved* path.

In the Kitselman machine all of the spool-carriers at one side of the spindles are *attached together* and *moved* from one section to another through the instrumentality of a *common bar,* while in the defendants' machine this is not the case, as the spool-carriers are each *separate* from the others and move *independently* of them.

In the Kitselman machine the spindles are *fast* with the pinions and *rotate* with them and necessarily so, while in the defendants' machine this is not the case, as the spindles are fast with the *frame* and have the pinions *loosely* mounted on them and do not rotate with the pinions.

In the Kitselman machine the spool-carriers are shifted from one section to another *by a hand lever* provided for the purpose, while in defendants' machine this is not the case, as they are shifted *without* any lever and simply by *reversing* the direction of rotation of the *crank,* nor *could they be* transferred by sliding bars and hand levers.

In the Kitselman machine the spool-carriers are required to be supported at *both ends,* while in the defendants' machine this is not the case, as they are and are only required to be supported at *one end only.*

In the Kitselman machine the spool-carriers could readily *be taken out* and turned end for end and *reinserted* in place again, while in defendants' machine this is not the case as they cannot be *reinserted end for end* without first being reconstructed.

In the Kitselman machine the operativeness of the machine would be destroyed if we made the hollow spindles *stationary* instead of rotative, while in the defendants' machine this not the case, as the spindles *could* be made *rotative* instead of stationary if desired.

In the Kitselman machine the segmental ends of the side sections of the twisters make with the lateral end pieces of the central sections *wheels at both ends* of the twisters which rest in supports which permit of their rotation, while in the defendants' machine this is not the case, as the ends of the central spindles and the spool-carriers *form no wheels* and are received in no journals or bearings.

In the Kitselman machine the spool-carriers could not be transferred except when the parts have been brought to

a position *of rest* and the pinions are *stationary,* while in the defendants' machine this is not the case, as the spool-carriers cannot be transferred when the pinions *are at rest* or stationary, but only *when* they are *rotating.*

The spool-carriers of the Kitselman machine and the spool-carriers of the defendants' machine are so different in *construction* and are meant to be mounted and operated *in such radically different ways* that they cannot be interchanged or transferred from one machine to the other without a reorganization of such machine.

In view of all these radical and essential differences between the Kitselman machine and the defendants' machine it is evident, as it seems to us, that the two machines are constructed on an entirely different theory and they are intended to work in an entirely different way. They lack the identity of *means* and the identity of *operation* which, combined with identity of *result,* must be found to constitute infringement.

From the foregoing analysis and comparison, we submit that the court erred in holding that there was any infringement of the claims of the Kitselman patent by the defendant's machine. Owing to the wide diversity of the means employed, respectively, to secure the result, it was error to hold that there was substantial identity, and this irrespective of whether the Kitselman patent be treated as a pioneer or for improvements merely.

4. The fourth specific assignment of errors relates to the fact that the majority opinion of the Circuit Court of Appeals included various novelties in construction and operation in the Kitselman machine which were really old in

other patents long prior thereto and not referable to Kitselman.

Various statements contained in the court's opinion will show to one familiar with the art an evident misapprehension of the points of novelty in construction and operation referable to the Kitselman machine.

In contrasting the Davisson and Kitselman machines the court, on page 846, says that "in the Kitselman machine the spindle extends clear forward to the twisting zone, to which it carries, through its hollow center, the warp wire fully supported against side pulls." Kitselman was not the first to carry the spindles forward to the twisting zone to support the warp wires, as suggested by the court, nor do the expert witnesses for the complainant claim such novelty for him.

On page 257 of the Record, complainant's expert, Mr. See, in considering the Davisson 1883 patent laid stress on the fact that in this patent the reels were carried forward to the twisting zone so that the wire could be supported to the point of use. He said:

> "Davisson, in the first patent in suit, abandoned the troublesome rear portion of netting looms and mounted his reels *right at the twisting point*, causing them themselves to perform the twisting operation. He, for the first time in the art, placed his reels for the woof wire in this new position. The exigencies of the netting weave require the transfer of wires as they had been before transferred, but in his case he was confronted with the peculiar conditions of woof wires *disposed right in the twisting zone*, the transfer of the woof wires after each twist thus requiring the bodily transfer of the reels themselves. He accomplished this by providing his twisting spindles

> with cross-heads or cross-members bearing the woof reels as forwardly projecting members, and arranged to transfer his reels from the cross-head of one spindle transversely to the cross-heads of neighboring spindles."

Here one of the merits claimed by complainant's expert for this *Davisson* patent—more than three years prior in date to the Kitselman patent—was the very thing pointed out by the court as a merit in the Kitselman patent. Davisson was the one who provided hollow spindles through which the warp wires were carried and supported against side pulls right up to the twisting zone.

Mr. See furthermore says, on page 258, that *Kitselman* adopted this idea from the Davisson machine. In speak- of the work of Kitselman, he says:

> "He adopts the *frontal reel and twisting system* of Davisson; he adopts Davisson's hollow spindles and cross-heads and shifting reels. But he abandons Davisson's longitudinally moving spindles," etc.

The complainant's expert, Mr. Dayton, on page 383, starts out with a recognition of the fact that the Kitselman machine employs the methods of the Davisson patent and is merely an improvement upon the Davisson machine, and says:

> "The first proposition I make is that the Kitselman is manifestly, on its face, *a development of the Davisson invention.*"

On page 385 Mr. Dayton, in insisting that the *Davisson* invention was the *pioneer* invention and that the Kitselman was a mere improvement thereon, says:

> "The Davisson invention, revolutionizing or aban-

doning prior principles of construction, arrangement and operation, first made the portable or field wire fence machine possible or practicable, in my opinion, and it is by reason of Kitselman's *employment of the underlying principles* of the Davisson invention, and by the *addition* of his invention thereto, that such a field wire fence machine was, in fact, made, for the first time in the art, by him."

On page 388 Mr. Dayton, in further recognition of the fact that the Kitselman machine was a mere development and improvement upon the Davisson, said:

"The Kitselman machine thus admittedly having hollow spindles for warp wires, *which were new with Davisson,* and also having the weft or mesh wire spools arranged alongside these spindles and in front of the gears by which said spools are revolved about the warp wires, *also new with Davisson,* and making the mesh wire spools direct and active agents in the twisting operation, *as Davisson was the first to do,* omitting altogether the disk form of twister known to the art prior to Davisson, and, of course, omitting all those older devices accompanying the disk form of twister situated back of the twister disks and serving to keep the wires from entanglement on their way to the disk twisters, it is plain that Kitselman *proceeds directly from Davisson,* and that the art prior to Davisson is necessarily as irrelevant to Kitselman as to Davisson."

But without quoting farther, it is manifest that neither Mr. See nor Mr. Dayton, complainant's experts, regarded Kitselman as the first to extend hollow spindles forward to the twisting zone to support the warp wires against side pulls, as they both concede that Davisson was the one who did this.

But aside from the fact, stated by both of the complainant's experts, that Davisson carried the warp wires through

hollow spindles and supported the twisters at the zone of operation, this method of working was old in the prior art, as shown by a number of patents issued many years before the Kitselman patent. It had been done for a generation prior to the Kitselman patent.

As early as 1855 the idea of *locating* the spools which carried the material to be woven or twisted in advance of the gears for imparting rotation to them was well understood and provided for in patents. In the Hull patent of August 7, 1855, page 592, and in the McCahey & Salisbury patent of March 21, 1871, page 595, are illustrations of this arrangement.

The machines of these patents were for braiding whips, but precisely the same difficulty needed to be provided for in the braiding of whips as in the weaving of wire fabric for fences. In both cases it was important to bring the spindle up to the fighting line to prevent rear entanglement. Mr. Dayton, on page 356, says the braiding of a whip is an illustration of this. We cannot, therefore, be regarded as going into foreign and non-analogous arts when we also refer to whip braiding machines.

By looking at sheet 2 of the drawings of the Hull patent, the court will see the spools F which carry the threads or cords employed in the braiding operation mounted in frames which are rotated by the line of intermeshing gears at the bottom of the figure. Here the spool carriers are the twisters precisely as they are in the Davisson machine. A very similar arrangement is shown in Fig. 3 of the McCahey & Salisbury drawing where the court will see the spindles carrying the spools upon which the thread is

wound and the gears near the bottom of the machine for imparting rotation to them. In both these patents the spools are carried close to the twisting point and in the zone of operation.

The majority opinion of the court, on page 846, says:

> "Kitselman provided each twister at its central section with a spur gear of sufficient diameter to engage the gears of the adjacent twisters, and by this means imparted a simultaneous motion to the whole series of twisters."

The arrangement of a series of gear-wheels intermeshing with each other to cause the rotation of all of the spindles simultaneously was old at the date of the Kitselman invention. The court will see such arrangement in the Nesmith 1854 patent, in the Hull 1855 patent, in the McCahey & Salisbury 1871 patent, in the Fultz 1884 patent, in the Winsor 1884 patent, and in the Middaugh & Wilcox 1884 patent—to cite no others. The Middaugh & Wilcox patent will serve as a good illustration, and the court can see the line of intermeshing spur-wheels or gears well illustrated on page 665. It was an old thing and should not be enumerated as one of the novelties of the Kitselman patent.

On page 847 the majority opinion of the court in eulogizing the Kitselman invention says that "out of it practically came a new product."

What new product does the court mean? The *style* of woven-wire mesh was not a new product. The Davisson machine was capable of weaving *exactly* the same sort of

a fabric. This is repeatedly conceded by the complainant's experts.

On page 374 Mr. Dayton, in considering the Nesmith patent, says:

> "The further provision of holes through the intermediate gears permits the making of a fabric with any number of intermediate tension wires embraced in the converging twists of the mesh wires (*being the fabric which I believe was first producible by the Davisson machine and which is first shown in the art in Figs. 10 and 11 of the Kitselman patent*) and also permits the making of other than full width fabrics with special marginal wires on both edges of the fabric."

Figs. 10 and 11 of the Kitselman patent, above referred to, are the ones which particularly show the Kitselman fabric, which Dayton says was producible *on the Davisson machine,* and which was not, therefore, a *new* fabric or product with Kitselman. And yet the majority of the Court of Appeals seems to have fallen into the error of supposing that it was a new product!

On page 425 of the Record, in speaking of the machines of *each* of the patents in suit—including the Kitselman and the prior *Davisson* patent—Mr. Dayton said:

> "Each of said machines weaves or is capable of weaving, a diamond mesh wire fence fabrc with longitudinal tension wires passing through the middle of the diamonds and through the twists of the mesh wires at the angles of the diamonds and where said diamonds intersect and are joined. This fabric, or a machine capable of making it, was not known in the art of wire fence making *prior to the Davisson patent.*"

Thus Mr. Dayton dates back the capacity to make the *product* of the Kitselman patent to the *Davisson* patent,

and makes no claim that *Kitselman* has given to the farmer or anybody else a *new* product.

Further testimony to the same purport might be quoted were it deemed necessary. It is admitted by the witnesses that the Davisson machine could weave *exactly* the same fabric as is woven on the Kitselman machine. The fabric, *as a fabric,* was not new. When woven by the Davisson machine or the Kitselman machine the *fabric* had to be nailed to fence-posts to form it into a fence. The Kitselman machine did not fasten it to the fence-posts, but simply wove the fabric along the line where it was to be used, and, as a rod was woven, a post was set in the ground and the fabric nailed to the post. The fence, when completed, looked precisely alike, whether the fabric was woven on the Davisson machine or on the Kitselman machine. They could not be distinguished apart in *appearance,* in *operation,* in *utility.*

What new product, therefore, is the majority of the court talking about when it attributes a new product to the Kitselman machine? We submit and insist that the Kitselman machine produces simply an *old* product—an old *fabric.*

We have called attention to a few points, as above, to show that the majority of the court was laboring under a misapprehension in attributing features of construction, operation and result to the Kitselman patent to which it was not entitled, and which were referable to *prior* laborers in the same field.

In view of all the foregoing, we respectfully submit and insist that the majority of the Court of Appeals was wrong

in holding in effect that the complainants had shown *title* to the territory *where* the alleged infringing acts were committed, in holding that the Kitselman patent was a *pioneer* patent for a field machine, in holding that, even if it were a pioneer patent, the defendant's machine employed *similar* means for producing the desired result, and in holding that the Kitselman machine contained the various points of *novelty* and *merit* attributed to it in the court's opinion.

If Judge Grosscup and Judge Seaman, the majority of the Court of Appeals, were wrong in their conclusions, as we believe they were, then the only relief the petitioner can have must come from this court. If Judge Woods and Judge Baker were right in holding that the petitioner had done nothing to incur liability, as we believe they were, this court only has power to effectuate their opinion. We, therefore, earnestly believe this case is one in which the writ of certiorari should issue.

Respectfully submitted,

THOMAS A. BANNING.

EPHRAIM BANNING.

October, 1901.

Supreme Court of the United States.

October Term, A. D. 1901.

ALVA L. KITSELMAN AND DAVIS M. KITSELMAN, Petitioners, vs. KOKOMO FENCE MACHINE COMPANY, Respondent.	No. 389

SUGGESTIONS AGAINST CROSS-PETITION.

May it please the Court:

The petitioners filed their bill on four patents—the Davisson patent of December 4, 1883, the Kitselman patent of January 18, 1887, the Connor patent of February 1, 1887, and the Pope patent of September 26, 1893. His Honor Judge Baker held that the defendant infringed *none* of the patents. (Record 792.)

The petitioners appealed and the Circuit Court of Appeals found that the Kitselman patent should be considered as a pioneer patent and infringed. (Record 811.) The Court of Appeals expressly say that they agree with Judge Baker that there is no infringement unless the patents are pioneer patents. They found that the Kitselman patent might be so considered, and so reversed the decision of the court below. They said nothing about the Connor and Pope patents, but as these patents were both *subsequent* to the Kitselman patent they could not be pioneers—must

fail to meet the condition laid down as necessary to justify difference with the conclusions of the court below. As to the Davisson patent the court found it to be of the stationary loom type, like the 1854 Nesmith patent in this particular, and perhaps others. It was, therefore, lacking in pioneer qualities. In meaning the decision of the Court of Appeals is an *affirmance* of Judge Baker's decision on *all* the patents except the Kitselman. It was so regarded and the decree entered in the court below accordingly.

We then have all *four* of the judges who have passed on the Davisson, Connor and Pope patents *agreeing* that they are specific and not infringed and the cross-petition contains no special showing that they were wrong. Why should this court be bothered with them under these circumstances? If this were an original petition for a writ of certiorari as to these patents would it be granted? Should the requisites to the granting of a cross-petition be less than to an original petition? The effect of granting this cross-petition will be to cause a review of the decisions of the courts below where the four judges have fully agreed—a circumstance very persuasive as to the correctness of the decision—and where there is no particular showing that their decisions were wrong.

Nor are the patents in any way so interwoven with each other as to require the court to pass on them in deciding the questions arising on the Kitselman patent. The Davisson patent simply forms a part of the *state of the art* like any other prior patent, and the Connor and Pope patents are both *subsequent* to the Kitselman and so do not need to be looked at for any purpose.

The whole question simmers down to this: Will this court, because it granted a writ of certiorari as to one patent, grant it as to three others because they happen to be

included in the same bill, notwithstanding the difference of circumstances in the two cases? Is the case any different than if the three patents had been declared on in a separate bill, as they might have been, notwithstanding one and the same machine was thought to infringe them all?

We submit that the cross-petition presents no sufficient reason why it should be allowed, and respectfully ask that it be denied.

THOMAS A. BANNING.
EPHRAIM BANNING.

March, 1902.